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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,964	12/14/2001	Heidi Riedel	Beiersdorf 755-KGB	7321
27384	7590	01/12/2005	EXAMINER	
NORRIS, MCLAUGHLIN & MARCUS, PA 875 THIRD STREET 18TH FLOOR NEW YORK, NY 10022			JIANG, SHAOJIA ANNA	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/016,964

Applicant(s)

RIEDEL ET AL.

Examiner

Shaojia A. Jiang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-13, 15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-13, and 15-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 03, 2004 has been entered.

This Office Action is a response to Applicant's request for continued examination (RCE) filed November 03, 2004, and amendment and response to the Final Office Action (mailed November 03, 2003), filed November 03, 2004 wherein claim 14 is cancelled; claim 16 is newly submitted. Claim 7 is cancelled previously.

Currently, claims 1-6, 8-13, and 15-16 are pending in this application.

Claims 1-6, 8-13, and 15-16 are examined on the merits herein.

This application claims foreign priority to German Application No.100 63 342.0, filed on December 19, 2000 under 35 U.S.C. 119(a)-(d). The copy of certified copy of the priority has been filed with the instant Application. It is noted that the Germany Application is in Germany, no translation into English is provided.

### ***Claim Rejections - 35 USC § 103***

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 11, 13, and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bellon et al. (FR 2,789,397 with English translation of record).

Bellon et al. exemplify a facial foam composition or preparation comprising 22% PEG-100 stearate glyceryl stearate which is a polyethoxylated fatty acid ester in the instant claim 1 (I)-B: stearate having a chain 18 carbons and 100 of ethoxylation;

12% stearic acid which is a fatty acid in the instant claim 1 (I)-A: stearic acid having a chain 18 carbons;

6% octyldodecanol, which is a fatty alcohol in the instant claim 1 (I)-C having a chain 20 carbons; nitrogen added to the composition in 70% by volume which is one gas in claim 1 (II). See Example 1 and Table 1 (at page 10-11 and 16 of the English translation). The claims therein recite a method of caring for skin comprising applying the composition to the skin. Bellon et al. disclose that the lipid phase in Example 1 which is phase A, is 40.7% of total weight which is obtained from the sum total of phase A (see page 11).

Bellon et al. do not expressly disclose that the amount of PEG-100 stearate glyceryl stearate, a polyethoxylated fatty acid ester in the instant claim 1 (I)-B, is 2-20%.

Bellon et al. do not expressly disclose a ratio of A:B:C of 1:1:1.

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It would have been obvious to a person of ordinary skill in the art at the time the invention was made to optimize the amount of PEG-100 stearate glyceryl stearate, a polyethoxylated fatty acid ester to 20% from 22%, and a ratio of A:B:C of 1:1:1.

One having ordinary skill in the art at the time the invention was made would have been motivated to optimize the amount of PEG-100 stearate glyceryl stearate, a polyethoxylated fatty acid ester to 20% from 22%, since 22% of PEG-100 stearate glyceryl stearate may read about 20% or is very close to 20%. Moreover, the optimization of the ratio of A:B:C based on the prior art teachings, is considered well within conventional skills in pharmaceutical science, involving merely routine skill in the art.

It has been held that it is within the skill in the art to select optimal parameters, such as amounts of ingredients, in a composition in order to achieve a beneficial effect. See *In re Boesch*, 205 USPQ 215 (CCPA 1980).

Further, placing a known cosmetic composition or preparation in a package is deemed obvious since it is well within the knowledge and conventional skills in the art.

Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bellon et al. in view of Synder (4,708,813, of record).

Bellon et al. is applied as discussed above. The reference lacks a hydrophilic emulsifier.

Synder teaches a nonlathering cleansing mousse with skin conditioning benefits.

Sorbitan monostearate is taught as a surfactant that provides skin cleansing benefits

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and imparts a uniform dispersion of emollient and other ingredients in the composition. Surfactants are disclosed as comprising 1.5-15% of the composition. See abstract; Col. 4, line 26-Co1. 5, line 24.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the sorbitan monostearate of Synder to the composition of Bellone et al. because of the expectation of achieving a composition with greater skin cleansing benefits and which imparts uniformity to the emulsion.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bellone et al. as applied to claims 1-6, 11, 13 and 15 above, in view of Saint-Leger et al. (5,939,077 of record).

Bellone et al. is applied as discussed above. The reference lacks carbon dioxide.

Saint-Leger et al. teach cosmetic compositions. Carbon dioxide and nitrogen are taught as interchangeable gases that are used in producing cosmetic foams. See Col. 4, lines 7-15.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the nitrogen of Bellone et al. for carbon dioxide because Saint-Leger et al. teach carbon dioxide and nitrogen as equivalent gases for use in producing cosmetic foams.

### ***Response to Argument***

Applicant's arguments filed November 3, 2004 with respect to the rejections made under 35 U.S.C. 103(a) of record in the previous Office Action November 03,

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2003 have been fully considered but are not deemed persuasive as to the nonobviousness of the claimed invention over the prior art as further discussed below.

Applicant asserts that "The prior art does not reveal the choice and quantity of emulsifiers to be a result-effective variable effecting long-term stability of the preparation". Contrary to Applicant assertion, Bellone et al. disclose a substantially similar emulsifier system to the one claimed herein having all three essential ingredients wherein B and C are in the same amounts as claimed herein, except the amount of PEG-100 stearate glyceryl stearate is 22% not 20%. However, one of ordinary skill in the art would clearly recognize that 22% of PEG-100 stearate glyceryl stearate may read about 20% or is very close to 20%.

Thus, the claimed invention is clearly obvious in view of the prior art of Bellone et al.

Further, the record contains no clear and convincing evidence of nonobviousness or unexpected results for the combination method herein over the prior art. In this regard, it is noted that the specification provides no side-by-side comparison with the closest prior art in support of nonobviousness for the instant claimed invention over the prior art.

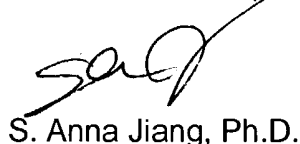
In view of the rejections to the pending claims set forth above, no claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (571)272-0627. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on (571)272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



S. Anna Jiang, Ph.D.  
Primary Examiner, AU 1617  
January 5, 2004